**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re Application of: | Kenneth D. Simone, Jr. |
| Serial No.: | 09/658,298 |
| Filed: | September 8, 2000 |
| Group No.: | 2142 |
| Confirmation No. | 3516 |
| Examiner: | Beatriz Prieto |
| Title: | METHOD AND APPARATUS FOR COMMUNICATING DURING AUTOMATED DATA PROCESSING |

**Mail Stop Appeal Brief - Patents**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

## REPLY BRIEF

Appellant has appealed to this Board from the decision of the Examiner, contained in a Final Office Action mailed March 14, 2006 ("*Final Office Action*") and the Advisory Action mailed May 23, 2006 ("*Advisory Action*"), finally rejecting Claims 1-10, 12, and 14. Appellant filed a Notice of Appeal and Pre-Appeal Brief Request for Review on June 12, 2006. Appellant received a Notice of Panel Decision from Pre-Appeal Brief Review dated July 12, 2006, rejecting Claims 1-10, 12, and 14. Appellant submitted an Appeal Brief on August 14, 2006. Appellant received a Notification of Non-Compliant Appeal Brief dated November 6, 2006. Appellant filed a Corrected Appeal Brief on December 5, 2006 for consideration of the Board. The Examiner responded in an Examiner's Answer mailed October 25, 2006 ( "*Examiner's Answer*"). Appellant respectfully submits this Reply Brief.

## ARGUMENT

### I. Related Appeals and Interferences: Amended

Since the Appeal Brief, an appeal was filed on October 17, 2006 for U.S. Patent Application Serial No. 09/658,238 that may directly affect or be directly affected by or have a bearing on the Board's decision regarding this appeal.

### II. Withdrawn Rejection

Appellant notes with appreciation the Examiner's consideration and withdrawal of the rejection of Claim 1 under 35 U.S.C. § 101. This resolves the ground of rejection addressed in Section II of the Appeal Brief, leaving only the ground of rejection in Section I (the rejection under 35 U.S.C. § 103) for the consideration of the Board.

### III. Claim Rejections Under 35 U.S.C. § 103 (Section I of the Appeal Brief)

The Examiner's rejection of Claims 1-10, 12, and 14 based upon the proposed *Hollingsworth-Ferrel-Belanger* combination must fail for any of the following reasons: (A) the proposed combination fails to teach or suggest every element of Appellant's claims, (B) there is no suggestion or motivation to combine the three references, and (C) *Ferrel* is non-analogous art and cannot be properly used in the proposed combination. In the Appeal Brief (Section I, sub-sections A, B, and C), Appellant fully explained each of these arguments for patentability. In the sub-sections that follow, Appellant simply refutes the arguments presented by the Examiner in the *Examiner's Answer*.

#### A. *Hollingsworth*, *Ferrel*, and *Belanger*, whether taken alone or in combination, fail to teach or suggest each and every element of the claims.

Using Claim 1 as an example, the proposed *Hollingsworth-Ferrel-Belanger* combination fails to teach or suggest: (1) "providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data" and (2) "automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmitting said communication occurs after editing a predetermined number of images." If the proposed combination fails to teach or suggest either element, then Claim 1 is patentable over the proposed combination.

**1. Claim 1 requires "providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data."**

As teaching these claimed aspects, the Examiner relies on teachings in the both the *Hollingsworth* and *Ferrel* references.

In response to Appellant's previously submitted arguments, the Examiner appears to concede that *Hollingsworth* fails to teach or suggest "at least one of said predetermined function definitions defining a function for editing image data." *See Examiner's Answer*, pp. 9-10 (identifying Appellant's arguments with respect to both *Hollingsworth* and *Ferrel* and responding by addressing only *Ferrel*). Appellant submits that *Ferrel* also fails to teach or suggest these claimed aspects. After discussing the teachings of *Ferrel*, Examiner concludes by stating, "Thus, Ferrel teaches a function (i.e. process, task or activity) for editing (e.g. creating/modifying) image data." *Examiner's Answer*, p. 10. However, a function for editing is not a function definition defining a function for editing. Accordingly, *Hollingsworth* and *Ferrel*, whether taken alone or in combination, fail to teach or suggest "at least one of said predetermined function definitions defining a function for editing image data," as required by Claim 1.

Second, Appellant submits that the references fail to teach or suggest the claimed "predetermined function definitions." Appellant agrees that the term "predetermined function definitions" should be given the broadest reasonable interpretation in light of the specification. *See Examiner's Answer*, p. 9. However, the Examiner obscures the meaning of the term by discussing the meaning of a "project definition." *Examiner's Answer*, pp. 8-9. However, the meaning of a "project definition" is distinct from the meaning of a "predetermined function definition." Claim 1 clearly shows that these are separate and distinct terms -- Claim 1 requires "a project definition . . . which includes: a plurality of function portions which each correspond to one of said function definitions." The Examiner further conflates these two terms by pointing to *Hollingsworth*'s process definition as teaching both "a project definition" and the "predetermined function definitions." *See Final Office Action*, p. 2 (asserting that *Hollingsworth* teaches "providing a set of predetermined process definitions" and pointing to *Hollingsworth*'s process definition as teaching "storing a project definition . . ."). Appellant respectfully submits that the same element in *Hollingsworth* cannot anticipate two disparate claim limitations.

Then, the Examiner further obscures the proper definition by effectively ignoring the claim requirement for "predetermined" function definitions. *See Examiner's Answer*, p. 9. After arguing why *Hollingsworth*'s process definition reads on the claimed "function definition," the Examiner concludes (without support) that *Hollingsworth* teaches a "predetermined function definition" merely because "process definition seems to be computer executable." *Examiner's Answer*, p. 9. However, computer executable process definitions do not teach predetermined function definitions, as required by Claim 1. Moreover, this logic renders "predetermined" meaningless. The Examiner's argument fails to appreciate that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970); *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374 (Fed. Cir. 2006) (construing the term "adjustable" to mean "adjustable by any means" places no meaningful limits on the term "adjustable.").

**2. Claim 1 requires "automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition, wherein transmitting said communication occurs after editing a predetermined number of images."**

The Examiner appears to rely upon *Ferrel* and *Belanger* to teach or suggest these claimed aspects. *See Examiner's Answer*, pp. 11-12. In essence, the Examiner appears to argue that the disparate references should be unnaturally pasted together to teach these claimed aspects:

> Ferrel teaches transmitting said communication occurs after editing image data. However, Ferrel does not explicit determine a predetermine number of images.
>
> * * *
>
> Belanger teaches a program configured to transmit a communication when a predetermined number of images on a site or electronic network have been identified.

*Examiner's Answer*, pp. 11-12. However, as shown by the Examiner's comments, neither reference, whether taken alone or in combination, teaches or suggests "wherein transmitting said communication occurs after editing a predetermined number of images," as required by Claim 1.

**B. There is no suggestion or motivation to combine *Hollingsworth*, *Ferrel*, and *Belanger*.**

Nothing in *Hollingsworth*, *Ferrel*, or *Belanger* suggests or motivates the proposed combination. The Examiner, in the *Final Office Action*, merely stated that the teachings of one reference would improve the teachings of another reference. Now, in the *Examiner's Answer*, the Examiner responds by providing a summary what each reference allegedly teaches. *Examiner's Answer*, pp. 13-14. However, these summaries still fail to show the required motivation to combine the references in such a way as to produce the invention claimed by Appellant.

Obviousness can only be established where there is some teaching, suggestion, or motivation to do combine or modify the teachings of the prior art to produce the claimed invention. *In re Kahn*, 441 F.3d 977, 986, 78 U.S.P.Q.2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching requirement as a guard against using hindsight in an obviousness analysis). "[A] showing of a suggestion, teaching, or motivation . . . is an 'essential component of an obviousness holding.'" *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)). In determining the differences between the prior art and the claims, the question under § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q 871 (Fed. Cir. 1983). The mere summaries of the teachings of *Hollingsworth*, *Ferrel*, or *Belanger* fails to constitute the required evidence of obviousness.

Moreover, the Examiner seems to argue that the motivation to combine the references arises from the fact that both Appellant's claims and the references "generally relate[] to automated processing of multiple items of data." *Examiner's Answer*, pp. 12-13. However, a motivation to combine references cannot arise from the mere fact that the references may be analogous art.[1] Rather, the references must suggest the desirability and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q 182, 187 n.5 (Fed. Cir. 1986).

Accordingly, Claims 1-10, 12, and 14 are patentable over the proposed *Hollingsworth-Ferrel-Belanger* combination because there is no suggestion or motivation to

[1] Appellant does not admit that *Hollingsworth*, *Ferrel*, and *Belanger* constitute analogous art.

combine the references. For at least this reason, Appellant respectfully requests the Board to reverse the Examiner's rejection of Claims 1-17 and direct the Examiner to issue a notice of allowance.

### C. *Ferrel* is non-analogous art and cannot be properly used in the proposed combination.

The *Hollingsworth-Ferrel-Belanger* combination is improper because *Ferrel* is not analogous prior art. While the Examiner attempts to broadly characterize *Ferrel*'s field of endeavor, *Ferrel*, in fact, deals with online publication methods, namely an information retrieval server that indexes, searches, and retrieves online content and stories.

First, the Examiner mischaracterizes *Ferrel*'s field of endeavor. As summarized by Appellant in the Appeal Brief, *Ferrel* deals with an information retrieval server that indexes, searches, and retrieves online content and stories. The Examiner, however, relies upon *Ferrel*'s "field of the invention" and one sentence from the specification to support the assertion that *Ferrel* "generally relates to automated processing of multiple items of data," which allegedly describes Appellant's field of endeavor as well. *Examiner's Answer*, p. 14. Appellant respectfully disagrees. The field of endeavor for each must be more particularized than "automated processing of multiple items of data"; otherwise, one could argue that a wireless card for a laptop and a scanner are in the same field of endeavor as both deal with processing data.

The Federal Circuit has confirmed that such broad categorizations cannot be used to determine whether art is analogous. In *Wang Labs.*, the Federal Circuit found that an application and a reference were not necessarily in the same field of endeavor merely because they both related to memories. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 U.S.P.Q.2d 1767 (Fed. Cir. 1993).[2] Instead, the court found the application and the reference were non-analogous even though they both dealt specifically with single in-line memory modules (SIMMs). *Id.*

[2] The reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories. Furthermore, since memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas reference SIMM was developed for use in large industrial machine controllers and only taught the use of static random-access-memories or read-only-memories, the finding that the reference was non-analogous was supported by substantial evidence. *Id.*

Second, Appellant submits that the "field of the invention" found at the beginning of a patent application is largely irrelevant to the question of whether a reference constitutes analogous art. These intentionally general statements are not reliable indicators of what a reference actually discloses. Patent Office classification of references and the cross-references in the official search notes of the class definitions, on the other hand, are some evidence of analogy versus non-analogy. *In re Ellis*, 476 F.2d 1370, 1372, 177 U.S.P.Q 526, 527 (CCPA 1973). Further, the court has found the similarities and differences in structure and function of the inventions to carry even more weight than PTO classifications. *Id.*

Finally, even assuming, for the sake of argument, that the "field of the invention" is determinative of whether a reference is analogous, *Ferrel*'s description makes clear that that reference is non-analogous art. *Ferrel* defines it's field of the invention as "information retrieval systems and more particularly, to a system and method for indexing, querying and retrieving information in an on-line network." *Ferrel*, col. 1, ll. 11-15 (emphasis added). However, Appellant's field is "automated processing of multiple items of data and, more particularly, to a method and apparatus for automatically transmitting a communication during such automated data processing." *Specification*, p. 1, ll. 2-6 (emphasis added).

Accordingly, Claims 1-10, 12, and 14 are patentable over the proposed *Hollingsworth-Ferrel-Belanger* combination because *Ferrel* is non-analogous art and cannot be properly combined. Appellant respectfully requests the Board to reverse the Examiner's rejection of Claims 1-17 and direct the Examiner to issue a notice of allowance.

## CONCLUSION

Appellant has demonstrated that the present invention, as claimed in Claims 1-10, 12, and 14, is patentably distinct from the cited art. Accordingly, Appellant respectfully requests that the Board reverse the final rejection and instruct the Examiner to issue a Notice of Allowance of Claims 1-10, 12, and 14.

Although Appellant believes no fees are due, the Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.P.P.

Respectfully submitted,

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